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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/488,969

01/21/2000

William J. Baer

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08/17/2006

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/488,969

Applicant(s)

BAER ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: RCE filed 06/06/2006 to the original application filed 01/21/2000.
2. Claims 1-15 are currently pending in this application. Claims 1, 6 and 11 have been amended. Claims 1, 6 and 11 are independent claims.

Request Continuation for Examination

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/06/2006 has been entered.

Specification

4. The cross reference related to the application cited in the specification must be updated (i.e., update the relevant status, with PTO serial numbers or patent numbers where appropriate, on the Amendment filed 2/12/04, pages 2-3). Correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tabuchi**

(U.S. 6,606,633 – filed 09/1999) in view of McGraw Hill Primis Custom Publishing

(**McGraw**), 1998, pp. 1-12. McGraw was provided by Applicant in the IDS filed 4/13/04.

As to claims 1, 6, and 11:

Tabuchi teaches a method, a program storage device, and system for providing prerequisite checking in a system for creating compilations from a plurality of content objects stored in a data repository, each content object comprising a plurality of content entities, some of the content entities being prerequisites to others of the content entities (*e.g., structure rules defining a possible structure of relations of objects are accumulated and a rule searching means for checking a possibility/impossibility of relating of a data*

object with reference to the structure rule table; see the Abstract and col.5, lines 12-57), comprising the steps of:

- upon addition or removal of a content entity to or from the compilation, determining if the content entity has any prerequisite content entities, and if so, adding (*e.g., adding*) or removing (*e.g., deleting*) the prerequisite content entities (*e.g., see the rule adding and deleting discussion beginning at col.10, line 59*).

Tabuchi, however, does not specifically teach the content entity comprises information to be published.

McGraw teaches the content entity comprises information to be published (*e.g., a collection of modular, stand-alone text files that can be mixed and matched and then seamlessly arranged to create a book "on demand" ... compile parts of several texts and add articles, review notes, case studies...to create their on book*) [see the "What is Primis Database Publishing" discussion, page 3].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Tabuchi and McGraw because McGraw's teaching would have provided the capability for having the most up-to-date information integrated in a professionally published , customized textbook.

As to claims 2, 7 and 12:

Tabuchi teaches one or more of the prerequisites are conditional (*e.g., the rule searching means 122 sees, when a data object is ...or when to a; col.8, lines 57-62*).

As to claims 3, 8 and 13:

Tabuchi teaches the conditions for applying a prerequisite are defined in one or more rules (*e.g., rules; see the Abstract*).

As to claims 4, 9 and 14:

Tabuchi teaches in the case of more than one rules pertaining to the same prerequisite, further comprising the step of reducing the rule set if possible into a smaller set of rules (*e.g., see fig.5 and the deleting a structuring rule from the structuring rule table, beginning at col.11, line 11*).

As to claims 5, 10 and 15:

Tabuchi teaches the step of rewriting any negative rules as positive rules (*e.g., whether a structuring rule is being used in a compound document object or can not be recognized ... when the number of references of the designated structuring rule is not 0, the structuring rule in question will not be deleted; col.11, lines 23-37*).

Response to Arguments

6. Applicant's arguments filed 06/06/2006 have been fully considered but they are not persuasive. Applicant's arguments are substantially directed to the amended subject matter. The amended subject matter is addressed above with respect to the discussion of independent claims 1, 6, and 11.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Subler et al.	U.S. Pat. No. 5,646,992	Issued: Jul. 8, 1997
Mortimer et al.	U.S. Pat. No. 6,091,930	Issued: Jul. 18, 2000
Sachs et al.	U.S. Pat. No. 6,331,865	Issued: Dec. 18, 2001
Reynolds et al.	U.S. Pat. No. 6,411,993	Issued: Jun. 25, 2002
Santamaki et al.	U.S. Pat. No. 6,886,036	Issued: Apr. 26, 2005

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN


Heather R. Herndon
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